

REMARKS

In the Office Action¹, the Examiner rejected claims 1, 2, 4-9, and 11-15 under 35 U.S.C. § 112, first paragraph; and rejected claims 1, 2, 4-9, and 11-15 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,828,374 to Coleman et al. ("*Coleman*") in view of U.S. Patent No. 6,829,615 to Schirmer et al. ("*Schirmer*"), U.S. Patent No. 5,714,971 to Shalit et al. ("*Shalit*"), U.S. Patent No. 6,262,732 to Coleman et al. ("*Coleman II*"), and U.S. Patent Publication No. 2003/0073462 to Zatloukal ("*Zatloukal*").

By this amendment, Applicant amends claims 1, 2, 7-9, 14, and 15, and adds new claims 16-20. Claims 1, 2, 4-9, and 11-20 are pending.

I. The Telephonic Interview of April 2, 2009

Applicants would like to thank Examiner Ke for the telephone interview of April 2, 2009 with Applicants' representatives. Applicants discussed a proposed amendment with Examiner Ke during the interview. Examiner Ke agreed the proposed claim would distinguish the art of record. Accordingly, Applicants have amended the claims according to the proposal discussed during the interview.

During the interview, the Examiner also requested Applicants cite to the specification to support certain recitations of claim 1, such as "navigation to an independent element with the navigation input is sufficient to cause the independent element to become the selected element." Applicants respectfully submit that at least

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

page 4, lines 4-7 and from page 4, line 29 to page 5, line 2 of the specification support these recitations of claim 1.

II. The Rejection of Claims 1, 2, 4-9, and 11-15 under 35 U.S.C. § 112, first paragraph

The Office Action alleges that the specification does not support the "navigation input, other than the key used to establish the normal and decoupled mode" previously recited in independent claim 1 (Office Action at page 3). Applicants respectfully traverse, and submit that at least page 5, lines 6-7 of the specification support these recitations. In any event, the amended claims presented herein no longer recite a navigation input "other than" a key, and claim 1 is fully supported in accordance with 35 U.S.C. § 112, first paragraph.

Although of different scope from claim 1 and from each other, independent claims 8 and 15 are fully supported for similar reasons. Claims 2 and 4-7 depend from claim 1, and claims 9 and 11-14 were apparently rejected solely due to their dependence from rejected base claims (Office Action at page 3). Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 2, 4-9, and 11-15 under 35 U.S.C. § 112, first paragraph.

III. The Rejection of Claims 1, 2, 4-9, and 11-15 under 35 U.S.C. § 103(a)

Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1, 2, 4-9, and 11-15 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims.

A. The References Do Not Teach or Suggest the Recitations of the Claims

Claim 1, for example, recites a computer program product, tangibly embodied in a computer-readable storage medium, comprising instructions operable to cause data processing apparatus to “receive user input from a user to establish a decoupled mode when a key is pressed and held by the user, and to establish a normal mode when the key is released by the user; and receive navigation input distinct from the key used to establish the normal and decoupled modes” (emphasis added).

Coleman discloses a help index that can be searched using an “alpha scroll bar” (*Coleman*, Fig. 8, and col. 10, line 51 to col. 11, line 14). Letters on the alpha scroll bar can be selected by a number of methods, including “placing [a] cursor over a portion of slider 175, depressing [mouse] switch 46 and dragging the cursor and slider over the desired letter ... [and] releas[ing] [mouse] switch 46,” (*Coleman*, col. 11, lines 20-23) (emphasis added). However, the Office Action concedes that *Coleman* fails to teach or suggest the claimed “establish a decoupled mode when a key is pressed and held by the user, and to establish a normal mode when the key is released by the user” (Office Action at page 5). Therefore, as agreed to by the Examiner during the interview, *Coleman* does not teach or suggest “receiv[ing] user input from a user to establish a decoupled mode when a key is pressed and held by the user, and to establish a normal mode when the key is released by the user; and receive navigation input distinct from the key used to establish the normal and decoupled modes,” as recited by independent claim 1.

Schirmer discloses a method for managing and presenting information for a group of data objects which can be associated with other data objects (*Schirmer*, abstract). A user can select a data object, and be presented with a number of other data objects that are related to the selected data object (*Schirmer*, col. 6, lines 60-64, and Fig. 1). However, the Office Action concedes that *Schirmer* fails to teach or suggest the claimed “establish a decoupled mode when a key is pressed and held by the user, and to establish a normal mode when the key is released by the user” (Office Action at page 5). Therefore, as agreed to by the Examiner during the interview, *Schirmer* does not teach or suggest “receiv[ing] user input from a user to establish a decoupled mode when a key is pressed and held by the user, and to establish a normal mode when the key is released by the user; and receive navigation input distinct from the key used to establish the normal and decoupled modes,” as recited by independent claim 1.

Shalit discloses dragging an object to a “split bar box” which causes a second “pane” to open in a window (*Shalit*, col. 5, lines 5-10). The second pane displays the contents of the dragged object (*Shalit*, col. 5, lines 19-21). However, the Office Action concedes that *Shalit* fails to teach or suggest the claimed “establish a decoupled mode when a key is pressed and held by the user, and to establish a normal mode when the key is released by the user” (Office Action at page 5). Therefore, as agreed to by the Examiner during the interview, *Shalit* does not teach or suggest “receiv[ing] user input from a user to establish a decoupled mode when a key is pressed and held by the user, and to establish a normal mode when the key is released by the user; and receive

navigation input distinct from the key used to establish the normal and decoupled modes," as recited by independent claim 1.

Coleman II discloses a "drag and drop" of an object using a mouse (*Coleman II*, col. 4, lines 1-7). The Office Action relies on *Coleman II*'s drag and drop of an object when addressing the claimed establish a normal mode when a key is pressed and held by the user" (Office Action at page 6). During the interview, the Examiner confirmed his position that the drag and drop operation was indeed mapped to these recitations of claim 1. However, the Examiner also agreed that the claimed "navigation input distinct from the key used to establish the normal and decoupled modes" distinguishes *Coleman II*'s drag and drop operation. However, the Examiner did request that Applicants explain the distinction in this response.

As disclosed in *Coleman II*, the drag and drop operation using a mouse is performed by moving the mouse cursor to a desired object object, pressing and holding down a button on the mouse to select the object, "dragging" the object by holding the button down while moving the cursor, and "dropping" the object by releasing the mouse switch (*Coleman II*, col. 4, lines 1-8). Thus, in *Coleman II*'s drag and drop operation, the mouse switch is depressed to "navigate" by moving the object. Therefore, *Coleman II*'s mouse switch cannot constitute a "key" distinct from a "navigation input," because *Coleman II*'s mouse switch is used to move the object and therefore is part of any "navigation input" disclosed in *Coleman II*. Thus, as agreed to by the Examiner during the interview, *Coleman II* does not teach or suggest "receiv[ing] user input from a user to establish a decoupled mode when a key is pressed and held by the user, and to

establish a normal mode when the key is released by the user; and receive navigation input distinct from the key used to establish the normal and decoupled modes," as recited by independent claim 1.

Zatloukal discloses an "interchangeable cover" used to add control keys to a mobile device (*Zatloukal*, abstract). However, *Zatloukal* does not disclose or suggest using the control keys in a manner analogous to the claimed "key," e.g. to establish a normal or decoupled mode. Therefore, as agreed to by the Examiner during the interview, *Zatloukal* does not teach or suggest "receiv[ing] user input from a user to establish a decoupled mode when a key is pressed and held by the user, and to establish a normal mode when the key is released by the user; and receive navigation input distinct from the key used to establish the normal and decoupled modes," as recited by independent claim 1.

B. The Proposed Combination Is Improper

In the Amendment After Final filed November 7, 2008, Applicants included a section pointing out certain deficiencies of the combination of *Coleman*, *Schirmer*, *Shalit*, and *Coleman II* (See Amendment After Final at pages 14-15). The Office Action has not addressed Applicants' position in this regard, stating only that Applicants' arguments are "moot in view of the new ground(s) of rejection" (Office Action at page 18).

However, while the Office Action adds the *Zatloukal* reference to the combination of *Coleman*, *Schirmer*, *Shalit*, and *Coleman II*, Applicants submit that the remarks from the Amendment After Final are not moot, at least because the Office Action continues to

rely on the combination of the *Coleman*, *Schirmer*, *Shalit*, and *Coleman II* references. Accordingly, Applicants have repeated the remarks from the Amendment After Final below for the Examiner's convenience. In the event the next Office Action includes a combination of any of the *Coleman*, *Schirmer*, *Shalit*, and *Coleman II* references, Applicants respectfully request a response to the position outlined below.

MPEP 2143.01(V) states, "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Here, the proposed modification would necessarily render the references unsatisfactory for their intended purpose.

As discussed above, the Office Action relies on a single input, e.g. a mouse switch, in addressing a number of different recitations of the claims. In doing so, the final Office Action effectively overloads the use of the mouse switch in a manner inconsistent with the teachings of the applied references. For example, if the mouse switch is used to drag and drop objects as in *Coleman II* or *Shalit*, the mouse switch cannot concurrently be used to select letters on an alpha scroll bar as in *Coleman*. Further, even assuming a mouse switch could be modified to both drag and drop objects and select letters on an alpha scroll bar, the mouse switch could not also be used to select a data object to see related data, as disclosed in *Schirmer*.

For the reasons discussed above, the proposed combination would overload the functionality of the mouse switch in manner not disclosed or suggested by the cited references. Further, even assuming a mouse switch could be modified as would be

required to combine the references, the Office Action has provided no explanation of how such a modification could be achieved. Therefore, the proposed combination would render the cited references unsuitable for their intended purposes, and there is no suggestion or motivation for the proposed combination.

C. Conclusion

As outlined above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Furthermore, the Office Action has failed to provide a motivation to combine *Coleman II* with the other applied references. Accordingly, the Office Action has failed to clearly articulate a reason why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1, as well as for claims 2 and 4-7 depending therefrom

Although of different scope, independent claims 8 and 15 recite elements similar to those of claim 1 already discussed. Therefore, Applicant respectfully requests withdrawal of the rejection of independent claims 8 and 15 under 35 U.S.C. § 103(a), as well as dependent claims 9 and 11-14 at least for the reasons discussed with respect to claim 1.

IV. New Claims 16-20

New claims 16-20 are allowable at least due to their dependence from independent claim 15, and for their own distinguishing features.

V. Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P

Dated: April 7, 2009

By: 
Philip J. Hoffmann
Reg. No. 46,340